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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,621	01/26/2004	Rolando M. Puno	MSDI-292/PC1008.00	8919
52196	7590	01/07/2009		
KRIEG DEVAULT LLP ONE INDIANA SQUARE, SUITE 2800 INDIANAPOLIS, IN 46204-2709			EXAMINER COMSTOCK, DAVID C	
			ART UNIT	PAPER NUMBER
			3733	
			MAIL DATE	DELIVERY MODE
			01/07/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/764,621	Applicant(s) PUNO ET AL.	
	Examiner DAVID COMSTOCK	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 5-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 5-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 10 December 2008 have been fully considered and are persuasive. The previous grounds of rejection have been withdrawn. However, upon further consideration, the claims are subject to rejection over EP 1 323 396 A2 (hereinafter '396; cited by Applicant) to DePuy AcroMed, Inc. alone or in view of Morrison (3,486,505; cited by Applicant), as set forth below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

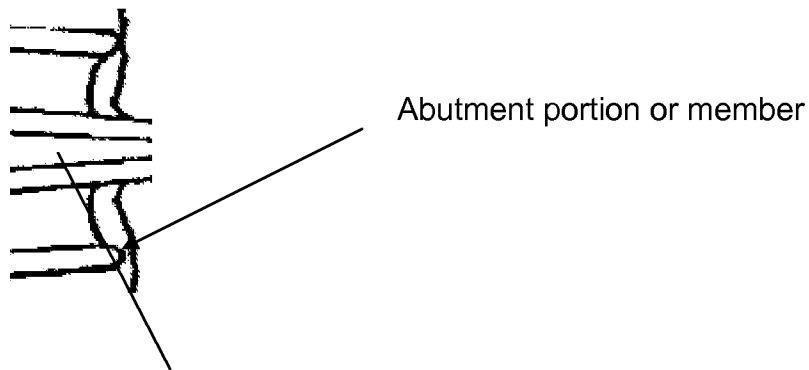
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 8-14, 17, 18, 20-42, 45-48 and 50-55 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 1 323 396 A2 ('396).

'396 discloses an implant insertion tool comprising a housing, e.g. 16, a pair of opposing guide members, e.g., 12A and 14A having planar guide surfaces, a spreader comprising a central body, e.g. 18, between the pair of guide members, and a drive member, e.g., 20. See, e.g., Fig. 1. The pair of guide members each comprise an elongated body and an elongated slot that extends between and opens along an inner surface and an outer surface. The device comprises a portion that can be seen as an

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abutment member (integral) or portion as claimed (see, e.g., Fig. 8A and Illustration below). The central body includes opposite wings, e.g. 94, extending therefrom slidably received in the slots of the guide members. An implant holder 412 may extend through a drive member (see, e.g., Fig. 18). The device may also comprise an adapter, e.g., 500, having arms, e.g. 508 and 509, extending therefrom, and projections, e.g. 515 and 516 (see, e.g., Fig. 16). Support members 50A and 50B are positionable in the space between the adjacent bony portions.



Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5-7, 19, 43 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 1 323 396 A2 ('396) in view of Morrison (3,486,505).

'396 discloses the claimed invention except for explicitly reciting that the connection between the housing and drive member could be threaded. However,

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Morrison discloses a similar device having a threaded connection between a housing 17 and drive member 15 in order to better control the depth of insertion of the device and implant (see, e.g., Fig. 1 and col. 1, lines 23-44). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have configured the device of '396 so as to have taken advantage of a threaded connection between the housing and drive member, in view of Morrison, in order to better control the depth of insertion of the device and implant.

Claims 15, 16 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 1 323 396 A2 ('396).

'396 discloses the claimed invention except for explicitly reciting the numerous forms the connection to the housing could take. It is noted that providing "fingers" and a crossbar is just one way of describing an ordinary separable hinge joint. The fingers form the opening for the crossbar or (axle or pivot pin or whatever one may wish to call it). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have substituted a connection comprising a joint with "fingers" or an opening and a "crossbar" or a pivot pin for the noted connection in '396 as doing so would involve nothing more than the substitution of an old and well-known and functionally equivalent hinge design that could have been employed by a person of ordinary skill in the art with predictable results equally well.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. For example, even if the noted portions of the '396 device could not be considered to be the claimed abutment portions or members, it is noted that reference EP 1 295 578 A2 cited by Applicant also shows abutment members e.g. 24A and 26B and it would have been obvious to have provided the '396 device with the same.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710 (a detailed message should be left if Examiner is unavailable). If attempts to reach the Examiner by telephone or voicemail are unsuccessful, the examiner's supervisor, Eduardo Robert, can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/David Comstock/
Examiner, Art Unit 3733

/Eduardo C. Robert/
Supervisory Patent Examiner, Art Unit 3733